

REMARKS

The Rejections Under 35 USC § 112, second paragraph

Claims 18 to 21 are amended to be dependent on claim 16. A new set of claims similar to claims 18 to 21 are added, but these claims are dependent on claim 17.

Claims 5 and 17 were rejected for not having antecedent basis for c''. The c'' is present in the structures of formulae (3a'') and (3b''). The formulae are redrawn to make this clear as the Examiner pointed out that the bond line above c in the formulae may have obliterated the apostrophes.

The Rejections Under 35 USC § 112, first paragraph

The rejection of claims 18 to 21 is overcome by the amendment to these claims that makes them dependent on claim 16, whereby a photoacid generator is present in the compositions.

Nonstatutory Double Patenting Rejection

A nonstatutory double patenting rejection is imposed on claim 16.

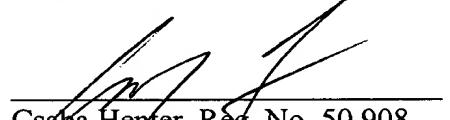
The Examiner alleges that claims 16 and 17 would not have been restricted from the parent application because all resist compositions wherein a photoacid generator was present were kept together in the restriction requirement imposed in the parent application. Applicants respectfully disagree. Claims 16 and 17 are dependent on claims 3 and 5, which were restricted from the parent application. Thus, most likely, these claims as well would have been restricted if present in the parent. Because claims 3 and 5 were restricted, it only follows that subject matter dependent thereon would also be restricted. In other words, since the compounds of claim 3 were found patentably distinct from the previously patented compounds, it follows that the compositions of claim 16 containing the claim 3 compounds are patentably distinct from the previously added compositions. This is particularly the case where the novelty derives from the compounds.

Claim 16 requires the presence of a specific base resin in the form of the high molecular weight silicone compound of claim 3. Claim 3 was restricted from the parent. The rejection is

solely based on alleged obviousness in the differences between the silicone compound present in the parent claim composition and the silicone compound in claim 16, i.e., the compound of claim 3, which was restricted from the parent application. Thus, this rejection is not proper.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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